

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT BARRITZ

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Appeal 2007-2843  
Application 09/829,894  
Technology Center 3600

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Decided: November 27, 2007

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Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and  
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-13, all the claims currently pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We REVERSE.

### THE INVENTION

Appellant's claimed invention is to a tool for creating retail websites in a semi-automated and/or substantially automated fashion (Spec. 7:9-15). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A website constructor, comprising:
  - a selection criteria module that establishes a selection criteria for merchandise selection;
  - a website organization module that defines a look and feel of a website constructed by the website constructor;
  - a graphic design module that creates at least one website layout and features setup for the website constructed by the website constructor;
  - a merchandise selection module in the website constructor that selects merchandise offered for sale on the website constructed by the website constructor that matches the selection criteria at least substantially automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors;
  - a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website constructed by the website constructor that has been selected by the merchandise selection module; and
  - a website builder that builds the website based on the criteria and conditions that have been setup by the foregoing modules.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bernardo	US 6,684,369	Jan. 27, 2004
Saroja Girishankar, <i>Build the e-commerce catalog</i> , Information Week, November 29, 1999.		

The following rejections are before us for review.

1. Claims 1 and 2 stand rejected under 35 U.S.C. 112, second paragraph, as indefinite.

2. Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bernardo in view of Girishankar.

### ISSUES

The first issue before us is whether Appellant has shown that the Examiner erred in rejecting claims 1 and 2 as indefinite. This issue turns on whether the terms “criteria” and “substantially automatically” are so broad they render the claims indefinite.

The second issue before us is whether Appellant has shown that the Examiner erred in rejecting claims 1-13 as unpatentable over Bernardo and Girishankar. This issue turns on whether the combination of Bernardo and Girishankar disclose a merchandise selection module and merchandise information downloading module as recited in claim 1.

### FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Bernardo discloses a tool for creating and modifying a Web site (Bernardo, col. 5, ll. 29-36).

2.The tool enables a Web site creator to select from among a plurality of features and options to include within a Web site (Bernardo, col. 6, ll. 32-34).

3.The tool provides several stored views to present the various options/features to the Web site creator so that the site creator may select the options/features desired for inclusion in the Web site (Bernardo, col. 6, ll. 49-52).

4.The tool identifies which templates in a library of stored templates are associated with or meet the options/features selected by the site creator (Bernardo, col. 7, ll. 49-50).

5.Upon identification of the templates, the site creator may be prompted for certain data to complete the template fields (Bernardo, col. 7, ll. 51-55.)

6.The tool then populates the template fields with the collected data (Bernardo, col. 8, ll. 1-3).

7.Bernardo does not disclose a merchandise selection module that selects merchandise offered for sale on the website constructed by the tool or a merchandise information downloading module that downloads merchandise information defining the merchandise offered for sale from a plurality of vendors.

8.Girishankar discusses an emerging class of automated tools and products which simplify the process of real-time aggregation and searching of online catalogs (Girishankar p. 1).

9. This new class of catalog management tools, among other things, aggregates and integrates catalog data into a central repository and provides the ability to cache catalog information locally (Girishankar p. 3).

10. Girishankar does not disclose a merchandise selection module, based on merchandise made available by a plurality of vendors, that selects merchandise offered for sale on the website and that matches the selection criteria at least substantially automatically, or a merchandise information downloading module that downloads merchandise information defining the merchandise selected by the merchandise selection module.

#### PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter

sought to be patented.” 383 U.S. at 17-18.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.*

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

## ANALYSIS

### *Rejection of claims 1 and 2 as indefinite*

The Examiner found that the term criteria is “so broad that establishing the metes and bounds of the claim are almost impossible”, and “the specification does not provide a standard for ascertaining” what is meant by “substantially automatically” (Answer 3-4). It is clear from Appellant’s Specification that the term “criteria” refers to any predefined condition for selection of merchandise (See Spec. 7:18-8:21 and 18:9-10). Furthermore, one skilled in the art would readily

appreciate that the phrase “substantially automatically,” as it is commonly used in the software arts and Appellant’s Specification, refers to an outcome or process wherein at least one step of the process occurs without user input (See Spec. 14:9-15:15 and 18:13-19:2). Although the use of the terms “criteria” and “substantially automatically” render claims 1 and 2 broad, that in and of itself does not render the claims indefinite. See *In re Gardner*, 427 F.2d 786, 788 (CCPA 1970) (Breadth is not indefiniteness). As such, we find that those skilled in the art would understand what is claimed when the claim is read in light of the specification, and thus, we do not sustain the Examiner’s rejection of claims 1 and 2 under 35 U.S.C. 112, second paragraph.

*Rejection of claims 1-13 as unpatentable over Bernardo and Girishankar*

Appellant contends that the combination of Bernardo and Girishankar fails to render claim 1 unpatentable because the combination fails to disclose each and every claimed element and is based on improper hindsight (Br. 6-8). The Examiner found that the combination of Bernardo and Girishankar discloses a merchandise selection module and merchandise information downloading module as claimed in as much as “Bernardo teaches populating a database based on selection criteria” and Girishankar “teaches populating a website with information from a plurality of vendors”(Answer 11).

Bernardo discloses a tool for creating and modifying a Web site that enables a Web site creator to select from among a plurality of features and options to include within a Web site (Finding of Facts 1 and 2). The tool provides several

stored views to present the various options/features to the Web site creator so that the site creator may select the options/features desired for inclusion in the Web site (Finding of Fact 3). Then the tool identifies which templates in a library of stored templates are associated/meet the options/features selected by the site creator (Finding of Fact 4). Upon identification of the templates, the site creator may be prompted for certain data to complete the template fields (Finding of Fact 5). The tool then populates the template fields with the collected data (Finding of Fact 6). Bernardo does not, however, disclose a merchandise selection module that selects merchandise offered for sale on the website constructed by the tool or a merchandise information downloading module that downloads merchandise information defining the merchandise offered for sale from a plurality of vendors (Finding of Fact 7).

Girishankar discusses an emerging class of automated tools and products which simplify the process of real-time aggregation and searching of online catalogs (Finding of Fact 8). This new class of catalog management tools, among other things, aggregates and integrates catalog data into a central repository and provides the ability to cache catalog information locally (Finding of Fact 9). However, Girishankar does not disclose a merchandise selection module or a merchandise information downloading module as recited in claim 1 (Finding of Fact 10). As such, the combination of Bernardo and Girishankar would not have led one having ordinary skill in the art to the website constructor having a merchandise selection module or a merchandise downloading module, as recited in claim 1. As such, we do not sustain the Examiner's rejection of claim 1, or its



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dependent claims 2-13, as unpatentable over the combination of Bernardo and Girishankar.

#### CONCLUSIONS OF LAW

We conclude Appellant has shown that the Examiner erred in rejecting claims 1 and 2 under 35 U.S.C. 112, second paragraph, as indefinite and claims 1-13 under 35 U.S.C. § 103(a) as unpatentable over Bernardo and Girishankar.

#### DECISION

The Examiner's decision to reject claims 1 and 2 under 35 U.S.C. 112, second paragraph, as indefinite and claims 1-13 under 35 U.S.C. § 103(a) as unpatentable over Bernardo and Girishankar is reversed.

#### REVERSED

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